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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/562,819

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Regis Houze

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7590

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EXAMINER

ABU ALI, SHUANGYI

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/562,819	Applicant(s) HOUZE ET AL.	
	Examiner SHUANGYI ABU ALI	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18, 19, 22-30, 34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18, 19, 22-30, 34 and 35 is/are rejected.
- 7) ☒ Claim(s) 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/30/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims 18 -19, 22- 30, and 34 -35 remain for examination wherein claim 18 is amended.

Claim Objections

Claim 23 objected to because of the following informalities: please change p1-l to pH. Appropriate correction is required.

New-ground Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 18 -19, 22 - 30, and 34 - 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/96403 to Du Bourg et al.(the paragraph and line numbers of

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the English language equivalent U. S. Patent Application No. 2004/0112559 will be cited below.)

Regarding claim 18, Du Bourg et al. disclose a starch composition comprising a DM (dry mater) in the range of 5 - 65 % ([0060]), a fixed nitrogen level at a range of less than 2% ([0055]), and a pH up to about 10 ([0088]).

The references differ from Applicant's recitations of claims by not disclosing identical ranges (DM: 10 - 50%, fix nitrogen level 0.6-1.4% and pH: 3.5 - 9) . However, the reference discloses "overlapping" ranges (DM :5-65 %, fix nitrogen level 0.6-1.4% and Ph : up to 10), and overlapping ranges have been held to establish prima facie obviousness (MPEP 2144.05).

Although Du Bourg et al. are about the viscosity measured by T method by applicant in claim 18, the viscosity is determined by the constituents of the composition, the claimed the viscosity would be necessary follow from the teaching of Du Bourg et al.

Regarding claim 19, Du Bourg et al. disclose a starch composition with a pH up to about 10 ([0088]).

Regarding claim 22, Du Bourg et al. disclose a starch composition with a fixed nitrogen level at a range of less than 2% ([0055]).

Regarding claim 23, Du Bourg et al. disclose a starch composition with a pH up to about 10 ([0088]).

Regarding claim 24, Du Bourg et al. disclose a starch composition with a pH 4 - 8.5 ([0088]).

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Regarding claims 25-26, Du Bourg et al. disclose the composition comprising saccharide [0075].

Regarding claims 27-29, Du Bourg et al. the composition at a temperature of 25 °C ([0059])

Regarding claim 30, Du Bourg et al. disclose that the composition can be used in paper making process ([0113]).

Regarding claims 34-35, Du Bourg et al. disclose a starch composition comprising a DM (dry mater) in the range of 5 - 65 % ([0060]). Du Bourg et al. disclose that the composition can be diluted by distilled water ([0058]) and this would clearly include any and all dilution rates as long as the defined additive is formed. In addition, depending on the viscosity of the additive for a specific application (i.e. paper making as defined by the reference), one skilled in the art would have found the optimal dilution rates through routine experimentation and optimization to obtain desired viscosity. The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages”, In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

Response to Arguments

Applicant's arguments filed 04/24/2009 have been fully considered but they are not persuasive.

Applicant argues that the instant application has a viscosity in the range of 275 to 930 mPa~s according to T test. The Examiner respectfully submits that the prior art discloses an overlapping range composition(a DM in the range of 5 - 65 %, a fixed nitrogen level at a range of less than 2%, and a pH up to about 10), and the viscosity of the composition will be necessary followed from the teaching of the prior art.

The applicant argues that the Examples of the prior art disclose that the composition has a viscosity outside the range of the instant application. The Examiner respectfully submits that Du Bourg et al. disclose a starch composition comprising a DM (dry mater) in the range of 5 - 65 % ([0060]), a fixed nitrogen level at a range of less than 2% ([0055]), and a pH up to about 10 ([0088]). While the reference does not provide a specific example which falls within the instant claims, it should be noted that "A reference can be used for all it realistically teaches and is not limited to the disclosures in its specific examples". See In re Van Marter et al 144 USPQ 421; In re Windmer et al 147 USPQ 518, 523; and In re Chapman et al 148 USPQ 711. Evidence of unexpected results must be commensurate in scope with the subject matter claimed. *In re Linder* 173 USPQ 356. To establish unexpected results over a claimed range, applicants should compare a sufficient number of tests both inside and outside (i.e. as well as the upper and lower limits) the claimed range to show the criticality of the claimed range. ***In re Hill* 284 F.2d 955, 128 USPQ 197 (CCPA 1960).**

The Examiner considers BE 626712 based on the argument that BE 626712 is listed on the international search report. A newly signed IDS is attached with the present office action.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHUANGYI ABU ALI whose telephone number is (571)272-6453. The examiner can normally be reached on Monday - Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J.A. LORENGO/

Supervisory Patent Examiner, Art Unit 1793

/Shuangyi Abu-Ali/

Examiner, Art Unit 1793